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WILLIAMS MORGAN & AMERSON PC
10333 RICHMOND
SUITE 1100
HOUSTON, TX 77042

EXAMINER

BAYAT, BRADLEY B

ART UNIT PAPER NUMBER

3621

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,385

Applicant(s)

BYERS, JAMES T.

Examiner

Bradley B. Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Applicant has canceled claims 1-3 in the response filed on April 13, 2005 and added new claims 4-23. Thus, claims 4-23 are pending and presented for examination on the merits.

Response to Arguments

Although applicant has not argued against the rejection with respect to claims 1-3 and the cited prior art reference, applicant has deemed the rejection moot in view of the new added claims. Thus, new claims 4-23 are rejected in view of the following new ground(s) of rejection.

Claim Rejections - 35 USC § 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 10-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for example a method of utilizing various software to, for instance scan a fingerprint of the contracting party, does not reasonably provide enablement for an apparatus with the necessary structures, hardware and relationship to encode the electronic contract and biometric information for the claimed subject matter.

In an apparatus claim the claim elements either describe the tangible hardware that is used to perform the method or by using mean-plus-function language, an apparatus claim essentially duplicates a corresponding method claim by obtaining a broader scope since they encompass equivalent structures that perform the same function. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly

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connected, to make and use the invention commensurate in scope with these claims. When expressing an element of a machine as a means for performing a particular function, the element is construed to cover the corresponding structure, material, or acts described in the disclosure. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998). Applicant's disclosure fails to disclose how to make and use the functional elements to yield the claimed invention.

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4-9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are described as follows in the context of the disclosed subject matter. Applicant's method steps describe obtaining an electronic contract, obtaining biometric information from one party to the contract and attaching the biometric information to the contract to identify the party to the contract.

However, claims 4-9 merely recite steps of obtaining and attaching the biometric to the contract and do not describe the essential steps necessary to verify the identity of the contracting party as described in the disclosure and recited in the body of the claims. For instance, is this biometric information being compared to a previously registered database to match and verify the identity of the contracting party? Otherwise, how is the verification occurring? As claimed, the method steps merely recite obtaining biometric information, attaching it to the electronic contract and storing it in a database.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Pu et al. (hereinafter Pu), US Patent Application Publication 2003/0105966 A1.

As per the following claims, Pu discloses:

4. A method, comprising:

- obtaining an electronic version of a contract (figure 2, step 66 – attach session code to contract);
- obtaining biometric information from at least one party to the contract (figure 2, step 71 – receive and encrypt biometric input); and
- associating the biometric information with the contract to uniquely identify the party to the contract (figure 2, step 74 – attach biometric to contract).

5. A method, as set forth in claim 4, wherein associating the biometric information with the contract to uniquely identify the party to the contract further comprises attaching an electronic

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representation of the biometric information to the contract (figure 2, step 72 – attaching biometric to contract).

6. A method, as set forth in claim 5, wherein associating the biometric information with the contract to uniquely identify the party to the contract further comprises storing the electronic contract and the electronic representation of the biometric information in a database (§28, contract and user's encrypted biometric forwarded to authentication server 50).

7. A method, as set forth in claim 5, wherein associating the biometric information with the contract to uniquely identify the party to the contract further comprises encoding and storing the electronic contract and the electronic representation of the biometric information in a database (§28, contract and user's encrypted biometric forwarded to authentication server 50).

8. A method, as set forth in claim 4, wherein obtaining biometric information from at least one party to the contract further comprises obtaining at least one fingerprint from at least one party to the contract (§27, biometric information such as a fingerprint entered).

9. A method, as set forth in claim 6, wherein obtaining at least one fingerprint from at least one party to the contract further comprises obtaining an electronic representation of at least one fingerprint from at least one party to the contract (§27, biometric information entered electronically by a fingerprint scanner).

10. An apparatus, comprising:

- means for obtaining an electronic version of a contract (§23-24, contractual relationship with service 30).
- means for obtaining biometric information from at least one party to the contract (§40, API 80 creates a biometric template using fingerprint input device 28) ; and
- means for associating the biometric information with the contract to uniquely identify the party to the contract (§27, the client program attaches the encrypted biometric to the contract).

11. An apparatus, comprising: an electronic contract; a device adapted for obtaining biometric information from a party to the electronic contract (§40, API 80 creates a biometric template using fingerprint input device 28); means for associating the biometric information with the electronic contract (§27, the client program attaches the encrypted biometric to the contract).

12. An apparatus, as set forth in claim 11, wherein the means for associating comprises a database adapted for receiving and storing the electronic contract and the biometric information (§28, authentication server).

13. An apparatus, as set forth in claim 12, further comprising an encoder adapted to encode the electronic contract and biometric information stored in the database (§27, symmetric or PKI encryption scheme).

14. An apparatus, as set forth in claim 12 further comprising a server adapted to store said database, and a computing device coupled to said server via a network said computing device having said device adapted for obtaining biometric information coupled thereto (figure 1 and associated text, ¶23).

15. An apparatus, as set forth in claim 14, wherein said server and said computing device are remotely located relative to each other (¶23, distributed computer network).

16. An apparatus, as set forth in claim 15, wherein said network coupling together the server and the computing device is an intranet (¶23, LAN).

17. An apparatus, as set forth in claim 15, wherein said network coupling together the server and the computing device is an internet (¶23, Internet).

18. An apparatus, as set forth in claim 14, wherein the server is a web server and the computing device includes a web browser for communicating with the web server (¶30, web browser for use in communicating with the service over the Internet).

19. An apparatus, as set forth in claim 11, wherein the device adapted for obtaining biometric information is adapted to obtain at least one fingerprint of a party to the electronic contract (figure 4, item 28, biometric input device).

20. An apparatus, as set forth in claim 19, wherein the device adapted for obtaining biometric information is a biometric application programming interface (bioAPI) consortium compliant device (figure 4, item 24, API 80 part of 24) .

21. An apparatus, as set forth in claim 19, wherein the device adapted for obtaining biometric information is a biometric application programming interface (bioAPI) consortium compliant fingerprint scanning device (§40, fingerprint scanner input device 28).

22. An apparatus, as set forth in claim 14, further comprising means for comparing the biometric information to a set of stored biometric information to verify the identify of a person associated with the biometric information (§37, image process matching against database 70).

23. An apparatus, as set forth in claim 22, further comprising means for declining the signature in response to failing to verify the identity of the person associated with the biometric information (§38-39, if biometric verified authentication server signs contract otherwise not verified with digital certificate).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested

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from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent 6,424,249 B1 to Houvener.
- US Patent 6,591,249 B2 to Zoka.
- US PAP 2002/0010857 A1 to Karthik.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8am-6: 30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bbb

James Trammell
Primary Examiner